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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,801	08/17/2000	G. John Stanton	265.0023 0101	5388

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EXAMINER

HAYES, ROBERT CLINTON

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 06/17/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,801

Applicant(s)

STANTON ET AL.

Examiner

Robert Hayes
Elizabeth C. Kemmerer, Ph.D.

Art Unit

1646 1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ
ID NO: 1, classified in class 514, subclass 2, for example.
2. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ
ID NO: 2, classified in class 514, subclass 2, for example.
3. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ
ID NO: 3, classified in class 514, subclass 2, for example.
4. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ
ID NO: 4, classified in class 514, subclass 2, for example.
5. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ
ID NO: 5, classified in class 514, subclass 2, for example.
6. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ
ID NO: 6, classified in class 514, subclass 2, for example.
7. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ
ID NO: 7, classified in class 514, subclass 2, for example.
8. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ
ID NO: 8, classified in class 514, subclass 2, for example.

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9. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 9, classified in class 514, subclass 2, for example.
10. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 10, classified in class 514, subclass 2, for example.
11. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 11, classified in class 514, subclass 2, for example.
12. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 12, classified in class 514, subclass 2, for example.
13. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 13, classified in class 514, subclass 2, for example.
14. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 14, classified in class 514, subclass 2, for example.
15. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 15, classified in class 514, subclass 2, for example.

16. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 16, classified in class 514, subclass 2, for example.
17. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 17, classified in class 514, subclass 2, for example.
18. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ ID NO: 18, classified in class 514, subclass 2, for example.
19. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ ID NO: 19, classified in class 514, subclass 2, for example.
20. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ ID NO: 20, classified in class 514, subclass 2, for example.
21. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 21, classified in class 514, subclass 2, for example.
22. Claims 1-35, each in part, drawn to methods of contacting cells with SEQ ID NO: 22, classified in class 514, subclass 2, for example.
23. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 23, classified in class 514, subclass 2, for example.

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24. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 24, classified in class 514, subclass 2, for example.
25. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 25, classified in class 514, subclass 2, for example.
26. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 26, classified in class 514, subclass 2, for example.
27. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 27, classified in class 514, subclass 2, for example.
28. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 28, classified in class 514, subclass 2, for example.
29. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 29, classified in class 514, subclass 2, for example.
30. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 30, classified in class 514, subclass 2, for example.

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31. Claims 27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 31, classified in class 514, subclass 2, for example.
32. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 32, classified in class 514, subclass 2, for example.
33. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 33, classified in class 514, subclass 2, for example.
34. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with SEQ ID NO: 34, classified in class 514, subclass 2, for example.
35. Claims 1-4, 6-9, 11, 13-27 and 29-34, each in part, drawn to methods of contacting cells with a specific combination of peptides SEQ ID NOs: 1-34 (Applicant must specify one particular combination), classified in class 514, subclass 2, for example.
36. Claim 36, in part, drawn to composition comprising SEQ ID NO: 1, classified in class 530, subclass 300, for example.
37. Claim 36, in part, drawn to composition comprising SEQ ID NO: 2, classified in class 530, subclass 300, for example.
38. Claim 36, in part, drawn to composition comprising SEQ ID NO: 3, classified in class 530, subclass 300, for example.

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39. Claim 36, in part, drawn to composition comprising SEQ ID NO: 4, classified in class 530, subclass 300, for example.
40. Claim 36, in part, drawn to composition comprising SEQ ID NO: 5, classified in class 530, subclass 300, for example.
41. Claim 36, in part, drawn to composition comprising SEQ ID NO: 6, classified in class 530, subclass 300, for example.
42. Claim 36, in part, drawn to composition comprising SEQ ID NO: 7, classified in class 530, subclass 300, for example.
43. Claim 36, in part, drawn to composition comprising SEQ ID NO: 8, classified in class 530, subclass 300, for example.
44. Claim 36, in part, drawn to composition comprising SEQ ID NO: 9, classified in class 530, subclass 300, for example.
45. Claim 36, in part, drawn to composition comprising SEQ ID NO: 10, classified in class 530, subclass 300, for example.
46. Claim 36, in part, drawn to composition comprising SEQ ID NO: 11, classified in class 530, subclass 300, for example.
47. Claim 36, in part, drawn to composition comprising SEQ ID NO: 12, classified in class 530, subclass 300, for example.
48. Claim 36, in part, drawn to composition comprising SEQ ID NO: 13, classified in class 530, subclass 300, for example.
49. Claim 36, in part, drawn to composition comprising SEQ ID NO: 14, classified in class 530, subclass 300, for example.

50. Claim 36, in part, drawn to composition comprising SEQ ID NO: 15, classified in class 530, subclass 300, for example.
51. Claim 36, in part, drawn to composition comprising SEQ ID NO: 16, classified in class 530, subclass 300, for example.
52. Claim 36, in part, drawn to composition comprising SEQ ID NO: 17, classified in class 530, subclass 300, for example.
53. Claim 36, in part, drawn to composition comprising SEQ ID NO: 18, classified in class 530, subclass 300, for example.
54. Claim 36, in part, drawn to composition comprising SEQ ID NO: 19, classified in class 530, subclass 300, for example.
55. Claim 36, in part, drawn to composition comprising SEQ ID NO: 20, classified in class 530, subclass 300, for example.
56. Claim 36, in part, drawn to composition comprising SEQ ID NO: 21, classified in class 530, subclass 300, for example.
57. Claim 36, in part, drawn to composition comprising SEQ ID NO: 22, classified in class 530, subclass 300, for example.
58. Claim 36, in part, drawn to composition comprising SEQ ID NO: 23, classified in class 530, subclass 300, for example.
59. Claim 36, in part, drawn to composition comprising SEQ ID NO: 24, classified in class 530, subclass 300, for example.
60. Claim 36, in part, drawn to composition comprising SEQ ID NO: 25, classified in class 530, subclass 300, for example.

61. Claim 36, in part, drawn to composition comprising SEQ ID NO: 26, classified in class 530, subclass 300, for example.
62. Claim 36, in part, drawn to composition comprising SEQ ID NO: 27, classified in class 530, subclass 300, for example.
63. Claim 36, in part, drawn to composition comprising SEQ ID NO: 28, classified in class 530, subclass 300, for example.
64. Claim 36, in part, drawn to composition comprising SEQ ID NO: 29, classified in class 530, subclass 300, for example.
65. Claim 36, in part, drawn to composition comprising SEQ ID NO: 30, classified in class 530, subclass 300, for example.
66. Claim 36, in part, drawn to composition comprising SEQ ID NO: 32, classified in class 530, subclass 300, for example.
67. Claim 36, in part, drawn to composition comprising SEQ ID NO: 33, classified in class 530, subclass 300, for example.
68. Claim 36, in part, drawn to composition comprising SEQ ID NO: 34, classified in class 530, subclass 300, for example.
69. Claim 36, in part, drawn to composition comprising a combination of SEQ ID NOs: 1-30 and 32-34 (Applicant must specify one particular combination), classified in class 530, subclass 300, for example.

The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different

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methods, restriction is deemed to be proper because these methods appear to constitute patentably distinct inventions for the following reasons: Groups 1-35 are directed to methods that are distinct physically, and are not required one for the other. Further, a search of a method of administering any one peptide would not reveal art on similar methods with any of the other peptides. Therefore, a search and examination of all of the methods in one patent application would result in an undue burden, since the searches for the methods are not co-extensive, and the subject matter is divergent.

Similarly, although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Groups 36-69 are directed to products that are distinct physically, are not required one for the other, and are therefore patentably distinct. Further, a search of any one peptide would not reveal art on any of the other peptides. Therefore, examination of all of the compositions in one application would present the examiner with an undue search burden.

Several pairs of Inventions are related as product and process of use (e.g., 36 and 1; 37 and 2; etc.). The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the peptides can be used to raise antibodies, or to isolate receptors and ligands.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements, and different classification, restriction for examination purposes as indicated is proper.

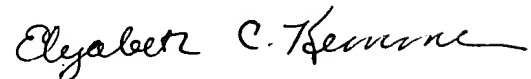
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Hayes, Ph.D., whose telephone number is (703) 305-3132.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, Ph.D., can be reached on (703) 308-4623. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



ECK
June 14, 2002

ELIZABETH KEMMERER
PRIMARY EXAMINER